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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,724	11/29/2001	Hirokazu Kawamoto	862.C2450	1850

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EXAMINER

WOO, ISAAC M

ART UNIT PAPER NUMBER

2166

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/995,724

Applicant(s)

KAWAMOTO ET AL.

Examiner

Isaac M. Woo

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-48, 58 and 63-75 is/are pending in the application.
- 4a) Of the above claim(s) 25-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58, 74 and 75 is/are rejected.
- 7) ☒ Claim(s) 63-73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/02/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2006 has been entered.

2. Claims 58 and 74-75 are amended. Claims 1-24 and 49- 57 are canceled. Claims 25-48 are withdrawn. Claims 58 and 63-75 are presented for examination for this office action.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 58 and 74-75 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

*A. Identify and Understand Any Practical Application Asserted for the Invention*

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claims 58 and 74-75, preamble recites "conflict process rule generation". However, claim body in claims 58, and 74-75 do not provide any step for generating the conflict process rule, which does not provide any tangible application result. Therefore, the claim is not a statutory system and should be rejected under § 101 as not being tangible.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 58 and 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"which *can be* commonly applied" in line 15 of claim 58, line 16 of claim 74 and line 17 of claim, " can be", renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 58 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hower, Jr. et al (U.S. Patent No. 5,467,434, hereinafter, "Hower") in view of Berstis (U.S. Patent No. 6,801,911).

With respect to claim 58, Hower teaches memory configured to store a principal rule that corresponds to a part of the conflict process rules (col. 7, lines 25-67 to col. 8, lines 1-16); and inference engine configured to generate a complementary rule that corresponds to the rest of the conflict process rules based on the principal rule stored in the memory (col. 8, lines 25-67 to col. 8, lines 1-16), and to additionally write the complementary rule in the memory (col. 8, lines 17-65), wherein the memory stores the conflict process rules as a conflict process rule description file(col. 8, lines 17-65); and wherein the conflict process rule description file describes a local rule which can be applied to a specific printing device (col.4, lines 27-48), and a universal rule description file that describes a universal rule which can be commonly applied to a plurality of printing devices is externally referred to (col. 9, lines 14-30). Hower does not explicitly disclose description file is described in accordance with a predetermined markup language. However, Berstis teaches file is standard description language refers to as

HyperText Markuop language (HTML) (col. 2, lines 9-37). Therefore, based on Hower in view of Berstis, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to utilize the teaching of Bertis to the system of Hower in order to provide user interface and document of network user interface's protocol.

With respect to claim 74, Hower teaches memory configured to store a principal rule that corresponds to a part of the conflict process rules (col. 7, lines 25-67 to col. 8, lines 1-16); and inference engine configured to generate a complementary rule that corresponds to the rest of the conflict process rules based on the principal rule stored in the memory (col. 8, lines 25-67 to col. 8, lines 1-16), and to additionally write the complementary rule in the memory (col. 8, lines 17-65), wherein the memory stores the conflict process rules as a conflict process rule description file(col. 8, lines 17-65); and wherein the conflict process rule description file describes a local rule which can be applied to a specific printing device (col.4, lines 27-48), and a universal rule description file that describes a universal rule which can be commonly applied to a plurality of printing devices is externally referred to (col. 9, lines 14-30). Hower does not explicitly disclose description file is described in accordance with a predetermined markup language. However, Berstis teaches file is standard description language refers to as HyperText Markuop language (HTML) (col. 2, lines 9-37). Therefore, based on Hower in view of Berstis, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to utilize the teaching of Bertis to the system of

Hower in order to provide user interface and document of network user interface's protocol.

With respect to claim 75, Hower teaches memory configured to store a principal rule that corresponds to a part of the conflict process rules (col. 7, lines 25-67 to col. 8, lines 1-16); and inference engine configured to generate a complementary rule that corresponds to the rest of the conflict process rules based on the principal rule stored in the memory (col. 8, lines 25-67 to col. 8, lines 1-16), and to additionally write the complementary rule in the memory (col. 8, lines 17-65), wherein the memory stores the conflict process rules as a conflict process rule description file (col. 8, lines 17-65); and wherein the conflict process rule description file describes a local rule which can be applied to a specific printing device (col. 4, lines 27-48), and a universal rule description file that describes a universal rule which can be commonly applied to a plurality of printing devices is externally referred to (col. 9, lines 14-30). Hower does not explicitly disclose description file is described in accordance with a predetermined markup language. However, Berstis teaches file is standard description language refers to as HyperText Markup language (HTML) (col. 2, lines 9-37). Therefore, based on Hower in view of Berstis, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to utilize the teaching of Bertis to the system of Hower in order to provide user interface and document of network user interface's protocol.

***Allowable Subject Matter***

9. Claims 63-73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Isaac Woo  
September 12, 2006